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**COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Small Entity)**

Docket No.
LIPM-3298

In Re Application Of: Ruth Lipman



Serial No.
10/035,305

Filing Date
11/09/2001

Examiner
Coe, Susan

Group Art Unit
1654

Invention: APPARATUS, METHOD AND COMPOSITION FOR REPELLING ANIMALS

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TO THE COMMISSIONER FOR PATENTS:

This is a combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing an Appeal Brief.

Applicant(s) hereby request(s) an extension of time of (check desired time period):

One month Two months Three months Four months Five months

from: **October 18, 2003** Date _____ until: **Decemebr 18, 2003** Date _____

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Fee for Appeal Brief: \$165.00

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TOTAL FEE FOR APPEAL BRIEF AND EXTENSION OF TIME: \$640.00

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In Re Application Of: **Ruth Lipman**

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PATENT & TRADEMARK OFFICE
U.S. DEPARTMENT OF COMMERCE

Serial No.
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Invention: **APPARATUS, METHOD AND COMPOSITION FOR REPELLING ANIMALS**

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TO THE COMMISSIONER FOR PATENTS:

This combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition for extension of time under 37 CFR 1.136(a) is respectfully submitted by the undersigned:

Jerry Dudding
Signature

Dated: December 18, 2003

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Applicant(s): Ruth Lipman

Docket No.

LIPM-3298

Serial No.
10/035,305Filing Date
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Invention: APPARATUS, METHOD AND COMPOSITION FOR REPELLING ANIMALS

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DOCKET NO. LIPM-3298

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lipman, R.

Examiner: Coe, Susan

Serial No.: 10/035,305

Art Unit: 1654

Filed: 11/9/01

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For: **APPARATUS, METHOD AND COMPOSITION FOR REPELLING ANIMALS**

Honorable Commissioner for Patents
P.O. Box 1450
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BRIEF OF APPELANTS

This Appeal Brief, pursuant to the Notice of Appeal dated July 16, 2003, is an appeal from the rejection of the Examiner dated April 22, 2003.

REAL PARTY IN INTEREST

Ruth Lipman is the real party in interest.

RELATED APPEALS AND INTERFERENCES

None.

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STATUS OF CLAIMS

Claims 1-4 and 6-12 are currently pending. The Examiner has removed her rejection of Claims 1-4 and 6-12 under 35 U.S.C. 102(a) (See the Advisory Action, paper No. 10). Claims Serial No.: 10/035,305

1-4 and 6-12 have been rejected only under 35 U.S.C. 103(a). This Brief is in support of an appeal from the rejection of Claims 1-4 and 6-12.

STATUS OF AMENDMENTS

There are no After-Final Amendments which have not been entered.

SUMMARY OF INVENTION

The present invention discloses a method of repelling animals, comprising: extracting a plant of an Alliaceae family, Allium genus; and applying the extract to an exposed surface of a plant to repel animals, wherein an animal feeding on the plant is repelled. The Allium genus includes Allium Cepa (Linnaeus), Allium Ursinum (Linnaeus), Allium Sativum (Linnaeus): Bulbus, such as ramp, onions, chives, shallots, scallions, leeks, wild leek, garlic, garlic chives, wild garlic, ransoms and combinations thereof. The Allium Cepa (Linnaeus) includes White Lisbon, Southport White Globe, Southport Red Globe, White Spanish Bunching, White Knight, Red Creole, Red Burgundy, Red Grano, Red Granex and combinations thereof. See FIG. 3 and accompanying discussion in Example 1, pages 23-24, Example 2, pages 24-25 and Example 3, pages 25-26, supporting the claims that applying at least one gallon of the extract from a plant of an Alliaceae family, Allium genus, having an effective concentration of from about 1 to about 1,000 square feet of the surface of a plant and repeated a maximum of once per two and a half weeks from May to September, 2001, protected the plants from being eaten by animals such as Japanese beetle larvae and deer.

The present invention also discloses gelatin, water, polyethylene glycol with an average

molecular weight ranging from 300 to 600, fatty acid esters of polyglycerines, lecithins, silicone oils, sorbitan fatty acid esters, sorbates of fatty acids, polysorbates of fatty acids, waxes, polyglycerines, triglycerides, fatty acids, fatty oils, paraffins, and cooking oils are used to extract the plant of an Alliaceae family, Allium genus. See FIG. 2 and accompanying discussion on page 5 describing an embodiment in which organic liquids are used to extract the plant of an Alliaceae family, Allium genus. See also FIG. 2 and accompanying discussion on pages 6-11 describing an embodiments for obtaining organic extracts of the plant of an Alliaceae family, Allium genus. The extract may be powder. See FIG. 2 and accompanying discussion on pages 12-13 describing an embodiments for obtaining powdered extracts of the plant of an Alliaceae family, Allium genus. A flavor precursor such as S-methyl, S-ethyl, S-propyl, S-propenyl and S-allyl cysteine sulfoxides may be controlled in the extract. See also FIG. 2, and accompanying discussion on pages 13-16 describing an embodiment wherein using a freeze drying process to control the alliinase level in the powdered extract controls a flavor precursor such as S-methyl, S-ethyl, S-propyl, S-propenyl and S-allyl cysteine sulfoxides. The extract comprises at least one egg, having a yolk portion. Alternatively, the extract includes lecithin instead of egg. See FIG. 2 and accompanying discussion on pages 17-18 describing embodiments having egg or alternatively lecithin. One embodiment of the present method of repelling animals from plants comprises use of a preservative such as thiram. See FIG. 2 and accompanying discussion on page 6 describing an embodiment comprising an effective amount of a fungicide such as, for example, thiram.

ISSUES

1. Whether Claims 1-4 and 6-12 are unpatentable under 35 U.S.C. 103(a) over US Patent No. 5,417,973 ('973) in view of US Patent No. 4,965,070 ('070).
2. Whether Claims 1-3, 7, 11 and 12 under 35 U.S.C. 103(a) are unpatentable over Japanese Patent Application No. 1-139515 A ('515 A) in view of U.S. Patent No. 4,965,070 ('070).

GROUPING OF CLAIMS

The Claims of Issue 1 stand or fall together, and the Claims of Issue 2 stand or fall together.

ARGUMENT

ISSUE 1

Claims 1-4, and 6-12 Are Not Unpatentable Under 35 U.S.C. 103(a) Over US Patent No. 5,417,973 ('973) in view of US Patent No. 4,965,070 ('070) There Is No Motivation to Combine U.S. '973 in View of U.S. '070 and Therefore the Combination Is Improper.

Claims 1-4 and 6-12

The Examiner rejected Claims 1-4 and 6-12 under 35 U.S.C. 103(a) as being allegedly unpatentable over US Pat. No. 5,417,973 ("'973") in view of US Pat. No. 4,965,070 ("'070"). Appellant respectfully traverses the Examiner's rejection of Claim 1 under 35 U.S.C. 103(a) because there is no motivation to combine U.S. '973 in view of U.S. '070 and therefore the combination is improper.

The Examiner relies on a secondary reference, U.S. '070, that teaches "a deer repellant formulation for warding off a deer from a **plant**," to modify a primary reference, U.S. '973, that teaches "repelling pests (e.g. insects and birds) from an animal **carcass**" (emphasis added). The U.S. '070 and U.S. '973 Abstracts, respectively. Appellants respectfully contend that the Examiner's use of U.S. '070 to modify U.S. '973 is an improper combination because U.S. '973 only teaches "repelling pests (e.g. insects and birds) from an animal **carcass**," and U.S. '070 only teaches "a deer repellent formulation for warding off a deer from a **plant**" (emphasis added). The U.S. '973 and U.S. '070 abstracts. The only possibilities for modifying the primary reference of U.S. '973 with the secondary reference of U.S. '070 is to either: replace the animal of U.S. '973 with the **plant** of U.S. '070 or add the **plant** of U.S. '070 to the animal of U.S. '973. The combination of U.S. '973 and U.S. '070 is improper because modifying U.S. '973 to replace the animal **carcass** of U.S. '973 with the **plant** of U.S. '070 would destroy the teaching of '973, i.e., to repel pests from an animal **carcass**. U.S. '973 requires "preserving and preventing pest damage to an animal **carcass** or skin" (emphasis added). U.S. '973, column 2, lines 14-16. Additionally, nowhere does U.S. '973 teach or suggest placing a **plant** on the animal **carcass** for any purpose. Since protecting a **plant** is outside the scope of U.S. '973, Appellant respectfully contends combination of U.S. '973 with U.S. '070 is improper. See U.S. '973 generally, columns 1-2 and Examples. Additionally, U.S. '973 doesn't need the addition of a **plant** to protect the **carcass**. Accordingly, Appellant contends that the rejection of claims 1-4 and 6-12 is improper and the Examiner should withdraw the rejection.

The Examiner does not address the conflicting purposes of U.S. '973 and U.S. '070, or why one skilled in the art wanting to preserve or prevent damage to an animal **carcass** would

look to U.S. '070 to modify U.S. '973, as discussed *supra*. Accordingly, Appellant contends that the rejection of claims 1-4 and 6-12 is improper and the Examiner should withdraw the rejection for lack of having established a *prima facie* case of obviousness.

The Examiner states "both references are concerned with the same problem, repelling animals from food sources. See the Final Office Action, Paper No. 8, mailed April 22, 2003, Page 3, Paragraph 7. However, the Examiner does not provide any support for her statement that repelling animals from an animal **carcass** is "the same problem" as repelling animals from **plants**. For example, the Examiner has offered no evidence to show that the same repelled animal would approach both a **plant** and a **carcass**, and the Examiner has offered no evidence to show that the **plant** extracts, as disclosed in the Examiner's cited references, would repel the same approaching animal. Accordingly, Appellant contends that the rejection of claims 1-4 and 6-12 is improper and the Examiner should withdraw the rejection.

In light of the foregoing discussion, Appellants respectfully contend that Claim 1 is in condition for allowance under 35 U.S.C. 103(a) over U.S. '973 in view of U.S. '070.

Claim 3

In addition to the arguments presented *supra* for claims 1-4 and 6-12, Appellant traverses the Examiner's rejection of Claim 3 because even if the combination of U.S. '973 in view of U.S. '070 were proper, which it isn't, the Examiner's rejection of Claim 3 under 35 U.S.C. 103(a) fails because U.S. '973 in view of U.S. '070 do not teach or suggest each and every feature of Claim 3. Claim 3 states "The method of claim 2, wherein the Allium Cepa is selected from the group consisting of White Lisbon, Southport White Globe, Southport Red Globe, White Spanish Bunching, White Knight, Red Creole, Red Burgundy, Red Grano, Red Granex and

combinations thereof." The Examiner does not support her rejection of Claim 3, that claims the Allium Cepa is the aforementioned varieties of onion. Accordingly, Appellant contends that the rejection of claim 3 is improper and the Examiner should withdraw the rejection.

In light of the foregoing discussion, Appellants respectfully contend that Claim 3 is in condition for allowance under 35 U.S.C. 103(a) over U.S. '973 in view of U.S. '070.

Claim 9

In addition to the arguments presented *supra* for claims 1-4 and 6-12, Appellant traverses the Examiner's rejection of Claim 9 because even if the combination of U.S. '973 in view of U.S. '070 were proper, which it isn't, the Examiner's rejection of Claim 9 under 35 U.S.C. 103(a) fails because U.S. '973 in view of U.S. '070 do not teach or suggest each and every feature of Claim 9. Claim 9 states "The method of claim 1, wherein the extract further comprises alliinase enzyme." The Examiner does not support her rejection of Claim 9, that teaches the extract further comprises alliinase enzyme. Accordingly, Appellant contends that the rejection of claim 9 is improper and the Examiner should withdraw the rejection.

In light of the foregoing discussion, Appellants respectfully contend that Claim 9 is in condition for allowance under 35 U.S.C. 103(a) over U.S. '973 in view of U.S. '070.

ISSUE 2

Claims 1-3, 7, 11 and 12 Are Not Unpatentable Under 35 U.S.C. 103(a) Over Japanese Patent Application No. 1-139515 A ('515 A) in view of U.S. Patent No. 4,965,070 ('070).

Claims 1-4 and 6-12

The Examiner rejected Claims 1-3, 7, 11 and 12 under 35 U.S.C. 103(a) as being allegedly unpatentable over JP Pat. Application No. 1-139515 A in view of U.S. Patent No. 4,965,070 ('070). Appellant respectfully traverses the Examiner's rejection of Claims 1-3, 7, 11 and 12 because one skilled in the art would not be motivated to combine JP '515 in view of U.S. '070 for the same reason Appellant traversed the Examiner's rejection of Claims 1-4 and 6-12 under 35 U.S.C. 103(a) *supra*. JP '515 teaches a repellent so that when applied to **garbage**, "**the garbage is not rummaged or scratched by dogs, cats and birds**" (emphasis added). See JP Pat. Application No. 1-139515 A, Abstract and Use/advantage.

The Examiner relies on a secondary reference, U.S. '070, that teaches "warding off a deer from a **plant** to modify a primary reference, JP '515, that teaches "repelling pests (e.g. insects and birds) from **garbage**" (emphasis added). The U.S. '070 and JP '515 Abstracts, respectively. Appellants respectfully contend that the Examiner's use of U.S. '070 to modify JP '515 is an improper combination because the purpose of JP '515 is to prevent **garbage** from being rumaged or scratched by dogs, cats and birds and the purpose of U.S. '070 is to protect **plants**. The only possibilities for modifying the primary reference of JP '515 with the secondary reference of U.S. '070 is to either: replace the **garbage** of JP '515 with the **plant** of U.S. '070 or add the **plant** of U.S. '070 to the **garbage** of JP '515. The combination of JP '515 with U.S. '070 is improper

because modifying JP ‘515 to replace the **garbage** of JP ‘515 with the **plant** of U.S. ‘070 would destroy the teaching of JP ‘515, i.e., preventing **garbage** from being rumaged or scratched by dogs, cats and birds. See the U.S. ‘070 and JP ‘515 Abstracts. JP ‘515 requires "preventing **garbage** from being rumaged or scratched by dogs, cats and birds" (emphasis added). The JP ‘515 generally, Abstract and Use/advantage. Additionally, nowhere does JP ‘515 teach or suggest placing a **plant** in the **garbage** for any purpose. Since protecting a **plant** is outside the scope of JP ‘515, Appellant respectfully contends combination of JP ‘515 with U.S. ‘070 is improper. See JP ‘515 generally, Abstract and Use/advantage. Additionally, JP ‘515 doesn’t need the addition of a **plant** to prevent **garbage** from being rumaged or scratched by dogs, cats and birds. Accordingly, Appellant contends that the rejection of Claims 1-3, 7, 11 and 12 is improper and the Examiner should withdraw the rejection.

The Examiner does not address the conflicting purposes of JP ‘515 and U.S. ‘070, or why one skilled in the art wanting to prevent animals from rummaging or scratching **garbage** would look to U.S. ‘070 to modify JP ‘515, as discussed *supra*. Accordingly, Appellant contends that the rejection of Claims 1-3, 7, 11 and 12 is improper and the Examiner should withdraw the rejection, for lack of having established a *prima facie* case of obviousness.

The Examiner states, but does not support her conclusion that both references are concerned with the same problem, repelling animals from food sources and that they are considered to be in the same field of invention. Appellant’s submit that nowhere does JP ‘515 teach repelling animals from food sources, at all. See JP ‘515 generally, Abstract and Use/advantage. On the contrary, JP ‘515 does not teach or suggest the **garbage** is a food source, but instead JP ‘515 teaches preventing **garbage** from being rumaged or scratched by dogs, cats

and birds. See JP '515 generally, Abstract and Use/advantage. Since the Examiner does not provide any support for her statement that repelling animals from an **garbage** is "the same problem" as repelling animals from **plants**, Appellant contends that the rejection of Claims 1-3, 7, 11 and 12 is improper and the Examiner should withdraw the rejection.

In light of the foregoing discussion, Appellant respectfully contends that Claims 1-4 and 6-12 are in condition for allowance under 35 U.S.C. 103 (a) because none of the prior art cited by the Examiner teaches or suggests each and every feature of Claims 1-3, 7, 11 and 12.

Claim 3

In addition to the arguments presented *supra* for Claims 1-3, 7, 11 and 12, Appellant traverses the Examiner's rejection of Claim 3 because even if the combination of U.S. '973 in view of U.S. '070 were proper, which it isn't, the Examiner's rejection of Claim 3 under 35 U.S.C. 103(a) fails because JP '515 in view of U.S. '070 do not teach or suggest each and every feature of Claim 3. Claim 3 states "The method of claim 2, wherein the Allium Cepa is selected from the group consisting of White Lisbon, Southport White Globe, Southport Red Globe, White Spanish Bunching, White Knight, Red Creole, Red Burgundy, Red Grano, Red Granex and combinations thereof." The Examiner does not support her rejection of Claim 3, that claims the Allium Cepa is White Lisbon, Southport White Globe, Southport Red Globe, White Spanish Bunching, White Knight, Red Creole, Red Burgundy, Red Grano, Red Granex and combinations thereof. Accordingly, Appellant contends that the rejection of claim 3 is improper and the Examiner should withdraw the rejection.

In light of the foregoing discussion, Appellants respectfully contend that Claim 3 is in condition for allowance under 35 U.S.C. 103(a) over JP '515 in view of U.S. '070.

In summary, Appellant respectfully requests reversal of the 35 U.S.C.103(a) rejections of
Claims 1-4 and 6-12.

Respectfully Submitted,

Date: 12/18/03

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DOCKET NO. LIPM-3298

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lipman, R.

Examiner: Coe, Susan

Serial No.: 10/035,305

Art Unit: 1654

Filed: 11/9/01

For: **APPARATUS, METHOD AND COMPOSITION FOR REPELLING ANIMALS**

APPENDIX - CLAIMS ON APPEAL

1. A method, comprising:

extracting a plant of an Alliaceae family, Allium genus; and

applying the extract to an exposed surface of a plant to repel animals, wherein an animal feeding on the plant is repelled.

2. The method of claim 1, wherein the Allium genus includes Allium Cepa.

3. The method of claim 2, wherein the Allium Cepa is selected from the group consisting of White Lisbon, Southport White Globe, Southport Red Globe, White Spanish Bunching, White Knight, Red Creole, Red Burgundy, Red Grano, Red Granex and combinations thereof.

4. The method of claim 1, wherein the Allium genus is selected from the group consisting of

Serial No.: 10/035,305

Allium Cepa (Linnaeus), Allium Ursinum (Linnaeus), Allium Sativum (Linnaeus): Bulbus.

6. The method of claim 1, wherein the Allium genus is selected from the group consisting of ramp, onions, chives, shallots, scallions, leeks, wild leek, garlic, garlic chives, wild garlic, ransoms and combinations thereof.
7. The method of claim 1, wherein the Allium genus is extracted with a material selected from the group consisting of gelatin, water, polyethylene glycol with an average molecular weight ranging from 300 to 600, fatty acid esters of polyglycerines, lecithins, silicone oils, sorbitan fatty acid esters, sorbates of fatty acids, polysorbates of fatty acids, waxes, polyglycerines, triglycerides, fatty acids, fatty oils, paraffins, cooking oils and mixtures thereof.
8. The method of claim 1, wherein the Allium genus is selected from the group consisting of Allium cepa (onion); Allium niponicum ("nobiru"); Allium sativum (garlic); Allium wakegi ("wakegi"); Allium ursinum ("wild garlic" or ransoms); Allium vineale ("wild garlic" or ransoms); Allium ampeloprasum (leek); Allium fistulosum ("negi" Welch onion); Allium bakeri; Allium ascalonicum (shallot); Allium tuberosum ("garlic chives"); Allium tricoccum ("ramp or wild leek"); Allium triquetrum ("three-cornered leek"); Allium schoenoprasum (chive).
9. The method of claim 1, wherein the extract further comprises alliinase enzyme.
10. The method of claim 1, wherein the extract contains a flavor precursor selected

from the group consisting of S-methyl, S-ethyl, S-propyl, S-propenyl and S-allyl cysteine sulfoxides and combinations thereof.

11. The method of claim 1, wherein the extract further comprises at least one egg, having a yolk portion.

12. The method of claim 1, wherein the extract further comprises a preservative.